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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,688	10/05/2000	Kenneth O. Lipscomb	26006.0001U3	8953

7590

08/13/2002

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EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,688

Applicant(s)

LIPSCOMB ET AL.

Examiner

B. PRIETO

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s): _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restriction

1. This communication is in response to application filed 10/05/00, claims 1-27 remain pending.

2. Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 1-11 and 25-27 drawn to a system for distributing digital media assets to a plurality of use, classified in class 345 subclass 742.

II. Claims 13-18, drawn to a system for distributing digital media assets to a plurality of use, classified in class 707, subclass 104.1.

III. Claims 19-24, drawn to a system for distributing digital media assets to a plurality of use, classified in class 705, subclass 51.

3. Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 1-11 and 25-27, are drawn to a system for distributing digital media assets to a plurality of users including a master library of media assets accessible to the users via a plurality of media player devices executing a data client application that manages media assets licensed for use by the user, classified in class 345, subclass 742.

II. Claims 13-18, are drawn to a system for distributing digital media assets to a plurality of users including a master database of media assets accessible to the users via a plurality of media player devices including tracking and identification of users, classified in class 707, subclass 104.1.

III. Claims 19-24, are drawn to a system for distributing digital media assets to a plurality of use including a master library of media assets accessible to the users via a plurality of media player devices further including the sale of physical media assets and purchasing transactions of said physical media assets, classified in class 705, subclass 51.

4. The inventions are distinct, each from the other because of the following reasons: Inventions II-III and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

5. In this case, invention I has separate utility such as it is usable in a are drawn to a system for distributing digital media assets to a plurality of users including a master library of media assets accessible to the users via a plurality of media player devices executing a data client application that manages media assets licensed for use by the user, classified in class 345, subclass 742, which lacks maintaining a master database of media assets that can be used by one or more of a plurality of users each having at least one media player device; identifying and tracking in the master database those media assets for which each user has usage rights on a media player device associated with a user; wherein a single user may have multiple media player devices from which the user desires to experience media assets, and wherein the master database synchronizes with the database in each media player device of a user to provide a user with access to media assets from any of the user's media player devices, as required for invention II. And further lacks, receiving a request to provide access to a corresponding digital media asset for use by the user on a media player device in connection with the sale of a physical media asset to a user; receiving payment from the user for use of the digital media asset, by an Internet-based media asset retailer; and apportioning an amount of the payment between the operator of the computing center, retailers of the physical media asset and the media asset owner, as required for invention III.

Invention II has a separate utility such as it is usable in a system for distributing digital media assets to a plurality of users including a master database of media assets accessible to the users via a plurality of media player devices including tracking and identification of users, classified in class 707, subclass 104.1, which lacks a media library database server application that manages access to a master library of media assets that can be accessed by users via one or more communication networks; and a plurality of media player devices that communicate with the portal to access media assets for use, including a database client application that manages media assets licensed for use by a user and a media library database server application of the portal manages usage rights of users to media assets, the media library database server application of the portal synchronizes with the database client application in the media player device so that the database client application stores information identifying those

media assets that a user has licensed usage rights, as required for invention I. And lacks the above mentioned features for invention III. See MPEP 806.05(d).

6. Because these inventions are distinct for the reasons given above and because the search required for each group is different and not co-extensive for examination purpose because these groups would require different searches on PTO's classification class and subclass e.g. a) the Group I search (1-11 and 25-27) would require use of search classified in Class 345, subclasses 742, (which would not required for the Groups II-III); b) the Group II search (claims 13-18) would require use of search Class 707, subclasses 104.1, (which would not be required for the Groups I and III); and c) the Group III search (claims 19-24) would require use of search Class 705, subclasses 51 (which would not be required for the Groups I-II), therefore restriction for examination purposes as indicated is proper.

7. Restriction is required under 35 U.S.C. 121 to one of the above identified patentably distinct groups of designs. A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed, 37 CFR 1.143. Any reply that does not include election of a single group will be held non-responsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the non-elected.

8. Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over prior art will apply equally to all other embodiments. See Ex parte Appeal No. 315-40, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

9. In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with Ex parte Heckman, 135 USPQ 229 (P.O. Super. Exam. 1960).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Mark H. Rinehart can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6606. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239, (for Official communications intended for entry)

Or:

(703) 746-7240 (for Non-Official or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".

(BP)

B. Prieto
Patent Examiner
August 9, 2002



ROBERT B. HARRELL
PRIMARY EXAMINER
PRIMARY EXAMINER